



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

| APPLICATION NO.  | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO.      | CONFIRMATION NO.       |
|--|-------------|----------------------|--------------------------|------------------------|
| 10/528,964   | 03/18/2005  | Donald S Copland     | SHI-003FORus             | 9029                   |
| 7590<br>Smith Brandenburg & Novak<br>905 Ohio Pike<br>Cincinnati, OH 45245 |             |                      | EXAMINER<br>JOY, DAVID J |                        |
|  |             |                      | ART UNIT<br>1794         | PAPER NUMBER           |
|  |             |                      | MAIL DATE<br>11/01/2007  | DELIVERY MODE<br>PAPER |

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

|                              |                               |                                |  |
|------------------------------|-------------------------------|--------------------------------|--|
| <b>Office Action Summary</b> | Application No.<br>10/528,964 | Applicant(s)<br>COPLAND ET AL. |  |
|                              | Examiner<br>David J. Joy      | Art Unit<br>1794               |  |

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 06 August 2007.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) 1-6 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 7-25 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-25 are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 18 March 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## DETAILED ACTION

### *Election/Restrictions*

1. Applicant's election with traverse of Group III, Claims 7-25, in the reply filed on August 6, 2007 is acknowledged. The traversal is on the ground(s) that the search and examination of the entire application can be made without serious burden. This is not found persuasive because, as discussed in the written restriction requirement that was mailed on July 3, 2007, the inventions do not relate to a single, general inventive concept under the relevant PCT Rules. As such, given the fact that the inventions deal with different inventive concepts, the inventions have acquired a separate status in the art due to their recognized divergent subject matter. Therefore, to search all of the concepts claimed in the entire application would impose a serious burden on Examiner.

2. The requirement is still deemed proper and is therefore made FINAL.

### *Claim Rejections - 35 USC § 112*

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 7, 11-15, 24 and 25 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

5. In Claim 7, it is unclear as to where exactly the surfactant is deposited. If the surfactant is to be deposited on the substrate, then some definiteness as to which side of the substrate is necessary. If the surfactant is to be deposited on top of the image layer, which would seem to correlate with the drawings in the instant case, then that is what should be claimed.

6. As for Claims 10-18, all of the claimed limitations are process limitations (i.e., claiming how things are to be formed), whereas the invention of Claim 7 (on which each of these claims depends) is drawn to an article.

7. With regard to Claims 24 and 25, it is unclear as to where the coating is located in/on the article, in relation to the other layers/portions that are claimed as being part of the article (Claim 25 inherits the deficiency of Claim 24, given its dependency).

*Claim Rejections - 35 USC § 102*

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

9. Claims 7-9, 11-21 and 23 are rejected under 35 U.S.C. 102(e) as being anticipated by the U.S. Patent Application Publication of Godbey et al. (2002/0187181; hereinafter "Godbey").

10. Godbey teaches an article for applying and monitoring a surfactant/surface active agent that comprises a substrate (the carrier), an image positioned on the surface of the substrate (part of the one or more surface active agents in the layer/portion), and a surfactant deposited on the substrate (the one of more active agents) (see Abstract; see also ¶¶ [0001], [0004], [0005], [0007], [0008], [0019] and [0020]; see also Claim 1, et seq.). In addition, Godbey teaches that the surfactant is an epidermal surfactant (see ¶¶ [0006] and [0020]). Godbey also teaches that the surfactant can consist of any of the surfactants

taught in the instant application (see ¶¶ [0004], [0005], [0013], [0021], [0047]-[0049] and [0052]).

11. Godbey teaches that the image/decal is water-soluble and that it can be a material that is vegetable-based, compressed sugars, compressed salts, polymers and oligomers and gelatin (see ¶¶ [0024], [0045] and [0047]). Godbey recites these materials with regard to the composition of the carrier film/substrate, but as the image is positioned on the carrier film, it follows that the image will also be incorporated into these materials. In addition, Godbey teaches that the substrate/carrier is a material that can absorb and retain the surfactant that is provided thereon, such as paper, natural cloth, synthetic cloth, synthetic sponge, woven materials and non-woven materials (see ¶¶ [0019], [0024], [0029]-[0033] and [0045]).

12. Godbey also teaches that the article comprises an adhesive, as a means of securing the article to the skin of the user (see Abstract; see also ¶¶ [0008], [0019] and [0034]-[0041]). In addition, Godbey teaches that a single article can comprise one active agent or that the article can also comprise multiple active agents (see ¶ [0044]). Therefore, if one of the active agents is to be an image, and the other agent is a different type of agent/surfactant, it follows that as the surfactant either wears off of, or is

Art Unit: 1794

absorbed into, the skin of the user, then the image that is present could very easily fade or become more visible, depending on the nature of the surfactant that is covering the image portion of the article (see e.g., ¶¶ [0033] and [0050]).

### *Claim Rejections - 35 USC § 103*

13. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

14. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

15. Claims 10 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Godbey, as applied to Claim 7 above, and further in view of either applicant's

admissions or the U.S. Patent Application Publication of Dole et al. (2003/0044366; hereinafter "Dole").

16. Godbey teaches the claimed structure of the article as discussed above. In addition, Godbey recites a general teaching that the image can comprise colorants, dyes or printing (see ¶ [0033]). However, Godbey is silent as to the specific types of inks used to provide these colors or images. Applicant states that the ink is to be selected from a group of inks that are all well-known in the art. Alternatively, Dole, drawn to a composition that changes color, recites that there are a myriad of colorants that can be used that will effectuate a color-change (see ¶¶ [0012] and [0013]). Likewise, Dole teaches that the colorant can cause a color change as a surfactant dissipates (see *Id.*) Since Godbey, Dole and the instant application are all drawn to related fields of invention, and they all address the specific use of the same surfactants on the skin of the user, it would have been obvious to a person having ordinary skill in the art to use the inks, especially in a color-changing composition, that are claimed in the instant application.



*Conclusion*

17. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

|                 |         |                 |
|-----------------|---------|-----------------|
| US 6,106,852    | 08/2000 | Vineberg        |
| US 5,928,797    | 07/1999 | Vineberg        |
| US 2002/0114764 | 08/2002 | Berryman et al. |
| US 2002/0041851 | 04/2002 | Kamimoto        |
| US 2002/0022008 | 02/2002 | Forest et al.   |

18. Any inquiry concerning this communication or earlier communications from the examiner should be directed to David J. Joy whose telephone number is (571) 272-9056. The examiner can normally be reached on Monday - Friday, 8:00 AM - 4:00 PM EDT.

19. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Bruce H. Hess can be reached on (571) 272-1525. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

20. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only.

Art Unit: 1794

For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

A handwritten signature in black ink, appearing to read "Bruce Hess". The signature is fluid and cursive, with the first name "Bruce" and the last name "Hess" clearly distinguishable.

DJJ  
10/26/2007

BRUCE H. HESS  
PRIMARY EXAMINER  
GROUP 1300